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In re application of

Masahiro TAKEUCHI, et al.

Appln. No.: 10/521,940

Group Art Unit: 1634

Confirmation No.: 8998

Examiner: Katherine D. Salmon

Filed: January 21, 2005

For: NOVEL GENES RELATING TO CHRONIC RHEUMATOID ARTHRITIS

PAPER(S) FILED ENTITLED:

1. Response to Restriction Requirement

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DOCKET NO.: Q85885

ATTORNEY/SEC: Susan J. Mack/laj

Date Filed: July 7, 2006

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER



## PATENT APPLICATION

### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q85885

Masahiro TAKEUCHI, et al.

Appln. No.: 10/521,940

Group Art Unit: 1634

Confirmation No.: 8998

Examiner: Katherine D. Salmon

Filed: January 21, 2005

For: NOVEL GENES RELATING TO CHRONIC RHEUMATOID ARTHRITIS

### RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This responds to the Office Action, dated June 9, 2006. In the Office Action, the Examiner issued two Restriction Requirements.

#### **I. Subject Matter Restriction Requirement**

The Examiner required that Applicants elect one of the following groups for prosecution on the merits:

- Group I        -        Claims 1-2, drawn to a polypeptide.
- Group II       -        Claims 3-5, 7, and 9, drawn to a polynucleotide, expression vector, a cell, and a kit comprising a polynucleotide.
- Group III      -        Claim 6, drawn to an antibody.

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Group IV - Claim 8, drawn to a method for detecting rheumatoid arthritis comprising an assay step and a nucleotide sequence.

Group V - Claim 8, drawn to a method for detecting rheumatoid arthritis comprising an assay step and a polypeptide sequence.

In response, Applicants elect Group II, Claims 3-5, 7, and 9 for examination.

For the following reasons, the election is made with traverse.

The Examiner asserted that the Restriction Requirement is legally correct, because the claims of this national stage application are not so linked as to form a single general inventive concept under PCT rule 13.1. Specifically, the Examiner stated that the single general inventive concept shared by each of the groups is SEQ ID NOs: 1, 3, 5, 7, and 9. However, the Examiner asserted that Genebank Accession Number AF212238 (March 2, 2001) teaches an isolated nucleic acid that is 99% identical to SEQ ID NO: 7 and would therefore hybridize to SEQ ID NO: 7.

The Examiner did not provide Applicants with a copy of the Genebank sequence. Thus, Applicants have no way of knowing if the Examiner's technical position is correct. In the absence of any evidence to support the Examiner's assertion, the restriction requirement is improper and should be removed.

## **II. Sequence Restriction Requirement**

The Examiner issued a Restriction Requirement with respect to the sequences, if Applicants elected any of Groups I, II, IV or V. Specifically, the Examiner required that if Applicants elected a group drawn to a nucleic acid sequence or an amino acid sequence, then Applicants must elect a single sequence for examination on the merits.

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In response, Applicants elect RA3 (the polynucleotide having SEQ ID NO: 3 and the polypeptide having SEQ ID NO: 4), with traverse.

Applicants respectfully submit that the Examiner's requirement that Applicants elect a single polypeptide or polynucleotide for prosecution is in direct conflict with the policy of the Director's Office. Thus, Applicants request withdrawal thereof.

Specifically, MPEP §803.04 states:

to aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Director has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application.

Further, MPEP 803.04 states that normally ten sequences constitute a reasonable number for examination purposes.

The elected claims recite eleven sequences. Applicants submit that this is a reasonable number for examination purposes, it being only one more than the MPEP recognizes as normally reasonable. Accordingly, reconsideration and withdrawal of the Restriction Requirement as to the sequences is requested, respectfully.

Applicants reserve the right to file a Divisional Application directed to non-elected claims 1-2, 6, and 8.

RESPONSE TO RESTRICTION REQUIREMENT

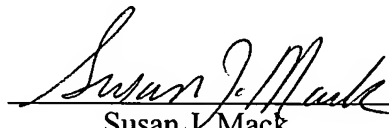
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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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